

## REMARKS

### I. Introduction

In response to the Office Action dated March 4, 2009, claims 1 and 9 have been amended. Claims 1-6, and 8-16 remain in the application. Re-examination and re-consideration of the application, as amended, is requested.

### II. Prior Art Rejections

On pages (2)-(5) of the Office Action, claims 1-6, 8-11, and 13-16 were rejected under 35 U.S.C. §102(e) as being anticipated by Krisbergh, U.S. Publication No. 20040078824 (Krisbergh). On pages (5)-(6) of the Office Action, claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Krisbergh and further in view of Russ et al., U.S. Publication No. 20020059642 (Russ). On pages (6)-(7) of the Office Action, claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Krisbergh and further in view of James, U.S. Publication No. 20020019987. On pages (8)-(9) of the Office Action, claims 4 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Krisbergh in view of Corvin, U.S. Publication No. 20010029610 (Corvin).

Applicants traverse the above rejections for one or more of the following reasons:

(1) Krisbergh, Russ, James, and Corvin do not teach, disclose or suggest a single device that contains numerous required elements including tuning hardware, VBI software, a screen, a speaker, and decompression software;

(2) Krisbergh, Russ, James, and Corvin do not teach, disclose or suggest a single device that has both a tuner and conditional access controls;

(3) Krisbergh Russ, James, and Corvin fail to teach, disclose, or suggest a single device that is mobile, portable, handheld, and provides the functionality as claimed.

Independent claims 1 and 9 are generally directed to receiving broadcast video programming in a user device. More specifically, video programming is encoded in the vertical blanking interval (VBI) and unused Active lines of a television channel. The television channel and encoded video programming is broadcast and received in a user device. The user device is configured to receive the normal over-the-air broadcasts (including the VBI) and to pass the encoded video programming (from the VBI). In addition, the user devices have VBI software that receives output from the tuning hardware and decodes the encoded video programming (from the VBI). Further, not only

does the user device have a screen and speaker but as amended, the user device is mobile, portable, and handheld. Further, the user device has decompression software that decompresses the decoded video programming and outputs analog audio and video signals to the screen and speaker of the user device itself.

In view of the above, it can be seen that the user device directly receives and tunes the broadcast television channel to receive video programming encoded in the VBI of the broadcast. Such a teaching is distinctly and uniquely nonobvious over the cited prior art.

Krisbergh merely describes an access system and method for providing interactive access to an information source through a television distribution system. The distribution system includes a television distribution network, headend distribution equipment at the headend of the distribution network, and a plurality of terminals at terminal ends of the distribution network. An input device and an upstream transmitter are associated with one of the terminals to input a command for the information source and to transmit the inputted command on an upstream channel of the distribution network, respectively. A headend server, upstream receiver, and data encoder are associated with the headend distribution equipment. The headend server is interfaced to the information source. The upstream receiver is interfaced to the headend server to receive and forward the command to the headend server. The headend server transmits the forwarded command to the information source, and the information source transmits responsive information to the headend server. A data decoder is interfaced to the terminal for decoding the encoded information from the television transmissions. The decoded information is then displayed on a display device. (See Abstract).

As recited above, the present claims explicitly require that the device contains both tuning hardware to receive the broadcast programming, as well as a speaker and screen to display the received information. In rejecting the claims, the Office Action relies on Fig. 6 and paragraph [0050] of Krisbergh to teach the screen and speaker of the device. However, contrary to that asserted, FIG. 6 illustrates set top converters or terminals 54 that feed separately to a display device 56. In this regard, the set top converters are clearly not part of the display device itself. Paragraph [0050] further enforces such an interpretation. The present claims specifically require that the speaker and screen are part of the device itself. Such a single device enables portability for the device to receive and view programming. However, Krisbergh cannot and does not provide such

capabilities. Further, since Krisbergh requires a set top box that is separate from the display device, Krisbergh serves to teach away from the present invention.

In addition, Applicants note that dependent claims 8 and 16 provide that the device itself contains subscriber management, conditional access, and encryption functions to control access to the video programming. In rejecting such claim elements, the Office Action relies on James' VBI receiver and namely paragraph [0026]. Paragraph [0026] provides for a VBI transceiver with various level filters, channel scanning capability, message buffer, subscriber communications processing, a message processor having an encoder and decoder circuitry, PCS interface, etc. However, what is clearly missing is the capability for a single device to have both a tuner, a screen and speaker, as well as conditional access capabilities. In fact, the lack of such a teaching serves to teach away from the presently claimed invention.

As is known in the prior art, conditional access systems commonly have set top boxes. Such set top boxes use conditional access modules (CAMs) that are cards that provide/enable security for the received programming. However, such CAMs explicitly do not have a tuner within the card. Instead, the common and known prior art require the separation of the tuner that exists independently in the set top box itself from the CAM. The CAM and set top box are synchronized together to provide content to be displayed on a television. However, the prior art does not combine the tuner with the conditional access services provided in the CAM. There are multiple reasons for such a lack of a combination – (1) to ensure greater security; (2) to enable low cost card productions that do not include an integrated tuner; (3) if the device had both the tuner and conditional access controls, anyone with a card would have a portable and potentially untrackable access capability to proprietary programming. Such factors teach away from a single card that has both a tuner and conditional access technology as set forth in the present claims.

The teaching away aspect of the claims can be found in various prior art references. For example, US Patent No. 7,463,737 (at FIG. 11 and co. 8, lines 57-col. 9, line 17) clearly illustrates that conditional access modules 1170, 1171 are entirely separate from, and not in the same unit as, the tuners 1020, 1021. Such a reference is merely an example of the many references that require and utilize a tuner in a completely separate module from that of the conditional access programming which exists in a conditional access module (CAM).

In view of the above, it can be seen that while James or Krisberg may teach the receipt of VBI, they both fail to also teach conditional access technology/controls within the same card. There is a reason for this as is evidenced and as is well known in the prior art. Further, none of the cited references even remotely allude to adding or combining such technology into a single card. The prior art in fact teaches away from such a combination and accordingly, there is no motivation to combine but instead there is a motivation not to combine the references in the manner suggested in the Office Action. Further, the overwhelming prior art actually teaches away from what the Examiner asserts is obvious. Such a teaching away indicates clear error in the Office Actions and a failure to establish a *prima facie* case of unpatentability.

Applicants further submit that while one cannot attack prior art references individually, there must be some motivation to combine the references (even under KSR). Instead of finding a motivation, the prior art clearly teaches away from the present invention.

In response to the above previously submitted arguments, the final Office Action first asserts that Krisberg teaches the claimed user device in Krisberg's set top terminal 54 and FIGs. 5/70 and 5/56. As clearly illustrated in FIG. 1, Krisberg's item 54 is a settop converter that is connected to a display device 56. Thus, they are completely separate devices. Again, the claims provide for a single user device that has multiple functionalities and not separate components as suggested by Krisberg. FIG. 5/70 is a settop communications module and FIG. 5 does not have a label 56. Instead, as again illustrated in FIG. 6, display device 56 is completely separate from device 54. The supporting text in paragraph [0030] states:

...As should be understood, each terminal 54 is for selecting one of the downstream channels 20 and is for being interfaced to a display device 56 for displaying the television transmission 24 carried on the selected downstream channel 20. Typically, the display device 56 is a tunable television set, although one skilled in the art will recognize that a non-tunable television monitor may also be employed without departing from the spirit and scope of the present invention.

Thus, as stated above, rather than teaching a single device, as claimed, the prior art serves to actually teach away from the present invention by specifically describing multiple devices. In addition, Applicants dispute the state of the art upon which the Examiner relies. In this regard, as evidenced above but Patent No. 7,463,737, CAMs are separate modules from the tuners.

Again, the Examiner continues to assert that Krisberg's user device has the speaker and screen as well as the other components. Applicants respectfully disagree with such assertions. In

addition, to more fully differentiate Krisberg's device from that of Applicant's, the claims have been amended to now recite that the claimed user device is mobile, portable, and handheld. Nowhere in Krisberg or any of the cited references is there even a remote possibility for Krisberg's terminal to be mobile, handheld, or portable, in any way, shape, or form. As illustrated by all of Krisberg's figures, the display device 56 is clearly not portable, is not handheld, and is not mobile – instead, it is large, stationary, and consistent with the prior art that the present invention overcomes in that Krisberg falls in line with a traditional television broadcast system. There is simply no capability to compare Krisberg with that of the presently claimed invention.

Moreover, the various elements of Applicants' claimed invention together provide operational advantages over Krisbergh, Russ, James, and Corvin do not . In addition, Applicants' invention solves problems not recognized by Krisbergh, Russ, James, and Corvin do not .

Thus, Applicants submit that independent claims 1 and 9 are allowable over Krisbergh, Russ, James, and Corvin do not. Further, dependent claims 2-6, 8, and 10-16 are submitted to be allowable over Krisbergh, Russ, James, and Corvin do not in the same manner, because they are dependent on independent claims 1 and 9, respectively, and thus contain all the limitations of the independent claims. In addition, dependent claims 2-6, 8, and 10-16 recite additional novel elements not shown by Krisbergh, Russ, James, and Corvin do not.

III. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

It is believed that no fees are due at this time. Nonetheless, should any charges be deemed necessary, please charge any such fees, or credit any overpayments, to Deposit Account No. 50-0494 of Gates & Cooper LLP.

Respectfully submitted,

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